

### REMARKS/ARGUMENTS

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested.

Claims 1-23 are pending in this case. Claims 1, 3, 4, 8, 10, 12, 13, and 17-20 are amended for clarity and with support in the originally filed disclosure at least at Fig. 11 and at paragraphs [0056] and [0094] of the published Specification. Thus, no new matter is added.

The outstanding Office Action rejected Claims 1-23 as unpatentable over Nishimura, et al. (U.S. Patent No. 7,386,623, herein "Nishimura") in view of Gatto, et al. (U.S. Pub. No. 2004/0193726, herein "Gatto").

Applicants respectfully traverse the rejection of the pending claims.

The outstanding Office Action asserts Nishimura as teaching every element of Claim 1 except the data request transmitting means and data receiving means of the communication terminal and the data transmitting means of the server, which it asserts Gatto as teaching.

The outstanding Office Action fails to address the argument made in the previous response that **Nishimura cannot properly be combined with any reference to teach the features that are conceded to be deficient in Nishimura.** Instead, the outstanding Office Action dismisses the arguments by asserting that Gatto, rather than Takihiro, could cure the deficiencies of Nishimura with regard to the claimed invention.

Applicants request that the arguments in the present response be fully considered and specifically addressed in any subsequent action, as required by MPEP § 707.07(f).

As the outstanding Office Action itself concedes, "Nishimura does not disclose that the scheduler downloads data at the scheduled time, but rather uploads data to be broadcast at the scheduled time." Nishimura describes live distribution of content from a user PC 106 to client PCs 107 through a streaming server 102. The user PC 106 reserves time for distribution of content from the PC 106, through the server 102, to client PCs 107. Clearly,

the entity in Nishimura that browses available times and reserves a time, the user PC 106, does not receive any data from the server 102. The **reservation** by the user PC 106 is **for transmission** of data from PC 106 to the server 102, **rather than for reception** of data from the server 102.

Because the outstanding Office Action evidences a recognition of the deficiency of Nishimura, the erroneous maintenance of a rejection based on Nishimura appears to stem from a misunderstanding of the requirements for a rejection under 35 U.S.C. § 103. The outstanding Office Action asserts, at page 5, that:

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the reservation system of Nishimura with the general concept of a terminal needing to schedule a download in advance, and then downloading that data from the server at a specific time as taught by Gatto in order to allow the server more control over the scheduling of downloads and bandwidth. (See [0005].)

However, the combination of “general concepts” is not permissible under MPEP § 2143. Instead, as discussed in the previous response, when a combination of references is asserted as teaching every element of a claim, both the **asserted modification**, or how the references are combined, as well as the **asserted motivation** for the combination, or why one of ordinary skill in the art would combine the references, must be specified in the rejection.

**MPEP § 706.02(j)(C) and 706.02(V) set out the requirement for asserting the modification.** As to the asserted motivation, the Court recently reiterated the requirement of MPEP § 2143.01 by stating that a “**patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art.**” KSR Int. Co. v. Teleflex Inc., 82 USPQ2d 1385, 1389 (2007). The Court stated

the importance of identifying “a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does.” *Id.*

Further, **under MPEP § 2143.01(V) the proposed modification cannot render the prior art unsatisfactory for its intended purpose**, and, **under MPEP § 2143.01(VI), the proposed modification cannot change the principle of operation of the prior art**.

In this case, the proposed modification of Nishimura, at page 5 of the outstanding Office Action, with Gatto’s asserted “general concept of a terminal needing to schedule a download in advance and then downloading the data from the server at a specific time,” is completely counter to the principle of operation of Nishimura and its intended purpose as a source of streaming content. The outstanding Office Action evidences an understanding of the principle of operation and intended purpose of Nishimura, as stated above. However, the outstanding Office Action proposes, for the second time, a modification of Nishimura that violates MPEP § 2143.01 by changing the operation of Nishimura to download data from the server at a specific time rather than transmit data to the server at a specific time. Because the “general concept” cited above is counter to the description of Nishimura, Nishimura cannot be modified, as asserted, to teach all the features of amended Claim 1 without derogating MPEP § 2143.01.

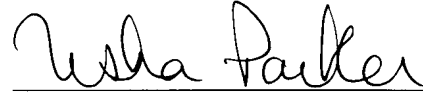
Because the combination of Nishimura and Gatto fails to establish a *prima facie* case of obviousness against Claim 1, Applicants respectfully request that the rejection under 35 U.S.C. § 103(a) of Claim 1 and Claims 2-7, which depend therefrom, be withdrawn.

Claims 8, 10, and 17, though differing in scope and/or statutory class from Claim 1, patentably define over the combination of Nishimura and Gatto for similar reasons as Claim 1. Thus, Applicants respectfully request that the rejection under 35 U.S.C. § 103(a) of Claim 8, Claim 9, which depends therefrom, Claim 10, Claims 11-16, which depend therefrom, Claim 17, and Claims 18-23, which depend therefrom, be withdrawn.

In light of the above discussion, the rejection in the outstanding Office Action is believed to be traversed and the present application is believed to be in condition for allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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